

REMARKS

Claim Status

The claims in consideration are claims 1-20. The independent claims are 1, 8, and 13.

Specification Objection

The Examiner has objected to the specification because of a typographical error. By this amendment, the typographical error has been corrected. Reconsideration is respectfully requested.

Claim Rejections - 35 U.S.C. §§ 102(b) and 103(a)

Claims 1-20 are rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over United States Patent No. 6,256,641 to Kasi et al. (hereafter "Kasi et al.").

With respect to claim 1, the Examiner states that "it is inherent that switches are used as claimed and that the switches will transfer the request from the client to the server (engine).

(Office Action, dated June 3, 2004, page 3). With respect to claim 8, the Examiner states that "it is inherent that switches

are used as claimed and that the switches will transfer the request from the client to the server (engine). With respect to claim 16, the Examiner states that "it is inherent that means by which to determine volume are present within Kasi's design. Applicant respectfully disagrees and requests reconsideration.

Applicant claims, among other things, "a system . . . wherein client applications requiring transactions are configured to send a request for such transaction to a selected one of said transaction switches, wherein said selected transaction switch is configured to send said transaction to a selected transaction engine to perform said one or more database accesses, and wherein said transaction switch selects said transaction engine in a manner that attempts to balance loading across said transaction engines in a predetermined manner." (Claim 1 and Emphasis added).

The remaining two independent claims (i.e., 8 and 13) have very similar limitations.

It is clear from the Applicant's claimed language that the client applications sends requests to the transaction switches. Also and significantly, the transaction switches send requests to the transaction engines. The Applicant's claimed transaction switches function in a unique way, are not found in the prior art,

and are certainly not inherent.

The Applicant's specification supports the claimed language. "Transaction switches 220-223 provide a standard interface to APIs 220-230 as shown in figure 2 . . . In general, the transaction switches are computers that accept requested transactions from APIs 230-233 and determine through which transaction engine 206-209 the transaction should be processed." (Specification, Page 5, Lines 5-10).

The system disclosed in Kasi et al. describes a user 11 that inputs a transaction into the client application 12. The client application 12 sends the transaction to the server application 20.

The server application 20 implements a read/write operation 36 with database 22. This system lacks the claimed transaction switches taught by the Applicant.

The Examiner is respectfully referred to MPEP §2131.01, which states that to "serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill."

citing, Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991).

Applicant notes that a reference has not been made of record that shows that it is inherent to have transaction switches that will receive requests from the client applications and then transfer the request to the transaction engines in a manner that balances loading. The system shown in the Kasi et al. reference is a three-tier system, wherein the client applications communicate with server applications, and the server applications communicate with database systems. (Kasi et al., Fig. 1). It is unclear how it is inherent to have Applicant's claimed transaction switches 220-223 that accept requested transactions from APIs 230-233 and determine through which transaction engine 206-209 the transaction should be processed. For these reasons, reconsideration is respectfully requested.

With regard to the obviousness rejection, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation in the references to modify the references or to combine reference teachings. However, the level of skill in the art cannot be relied upon to provide the suggestion to combine references.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. M.P.E.P. § 2143, citing, *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In this case, as explained above, the elements in the Applicant's claims are not found in the prior art. The third prong, at least, of a prima facie case has not been met because the prior art references when combined do not teach or suggest all the claim limitations.

The Applicant contends that the references cannot be modified to incorporate the features of the subject claims 1-20 without improperly utilizing the Applicant's disclosure, hindsight or some inherency theory. The courts have consistently held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, incentive, or motivation supporting the combination. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed.

In re: Jose Villena
Filed: January 17, 2001
Serial No.: 09/764,030
Page 14

Cir. 1990).

Accordingly, applicant believes that all pending claims are allowable. The Examiner is invited to telephone the undersigned, Applicant's Attorney of Record, to facilitate advancement of the present application.

Respectfully submitted,

Jose Villena

By



Daniel J. Bourque, Esquire
Registration No. 35,457
Attorney for Applicant(s)
BOURQUE & ASSOCIATES, P.A.
835 Hanover Street, Suite 301
Manchester, New Hampshire 03104
Telephone: (603) 623-5111
Facsimile: (603) 624-1432

Date:

8-12-04